

ESTTA Tracking number: **ESTTA484143**

Filing date: **07/18/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Orchard Yarn and Thread Company, Inc. DBA Lion Brand Yarn Company		
Entity	Corporation	Citizenship	New York
Address	34 West 15th Street New York, NY 10011 UNITED STATES		

Attorney information	Robert B. Golden Lackebach Siegel LLP 1 Chase Road Lackebach Siegel Building Scarsdale, NY 10583-4156 UNITED STATES rgolden@LSLLP.com, nsaraco@LSLLP.com Phone:914-723-4300
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Applicant Information

Application No	85525666	Publication date	06/19/2012
Opposition Filing Date	07/18/2012	Opposition Period Ends	07/19/2012
Applicant	Xamax Industries, Inc. 63 Silvermine Road Seymour, DE 06483 UNITED STATES		

Goods/Services Affected by Opposition

Class 024. First Use: 2008/01/31 First Use In Commerce: 2008/01/31 All goods and services in the class are opposed, namely: Cotton fabric
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3187172	Application Date	02/15/2006
Registration Date	12/19/2006	Foreign Priority Date	NONE
Word Mark	COTTON-EASE		

Design Mark	COTTON-EASE
Description of Mark	NONE
Goods/Services	Class 023. First use: First Use: 2002/05/20 First Use In Commerce: 2002/05/20 KNITTING AND CROCHET YARNS MADE IN WHOLE OR SUBSTANTIAL PART OF COTTON

Attachments	78815143#TMSN.jpeg (1 page)(bytes) Notice of Opposition.pdf (12 pages)(705995 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Robert B. Golden/
Name	Robert B. Golden
Date	07/18/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Application Serial No.: 85525666
Mark: CottonEase
International Classes: 24
Applicant: Xamax Industries, Inc.
Date of Publication: June 19, 2012

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ORCHARD YARN AND THREAD COMPANY,	:	
INC. D/B/A LION BRAND YARN COMPANY,	:	
	:	
Opposer,	:	
	:	Opposition No.:
v.	:	
	:	
XAMAX INDUSTRIES, INC.,	:	
	:	
Applicant.	X	

NOTICE OF OPPOSITION

Orchard Yarn and Thread Company, Inc. d/b/a Lion Brand Yarn Company ("Opposer"), a corporation duly organized and existing under the laws of the state of New York, with offices in New York, New York, believes that it will be damaged by the registration of the trademark CottonEase by Xamax Industries, Inc. ("Applicant") as applied for in Application Serial Number 85525666 ("Applicant's Application"), for use in connection with "Cotton fabrics" in International Class 24 ("Applicant's Goods").

As grounds for opposition it is alleged that:

1. Opposer is a corporation duly organized and existing under the laws of the state of New York, with offices in New York, New York.
2. Opposer manufactures, promotes, distributes, sells and provides a wide variety of products and services, including, without limitation, knitting and

crochet yarns, hobby craft kits comprised on yarns, needles, pieces of crocheted wool, polyester stuffing and instructions, newsletters and podcasts in the field of knitting, crocheting, handicrafts and products and accessories related thereto via e-mail fabrics, and related goods and services (“Opposer’s Goods”).

3. Opposer is the owner of the COTTON-EASE trademark (“Opposer’s Trademark”) for use on or in connection with Opposer’s Goods.
4. Opposer is the owner of U.S. Trademark Registration No. 3187172, registered on December 19, 2006, for the trademark COTTON-EASE (“Opposer’s Registration”) for use in connection with “Knitting and crochet yarns made in whole or substantial part of cotton” in International Class 23. True and correct copies of Opposer’s Certificate of Registration for Opposer’s Trademark, as well as the TARR and Assignment Records associated with the same, as printed from the U.S. Patent and Trademark Office’s website, are attached hereto as Exhibit 1.
5. Opposer has used Opposer’s Trademark in interstate commerce since approximately 2002.
6. Opposer’s Registration is valid and subsisting.
7. Through the years, Opposer has expended substantial amounts of money, time and effort in advertising, promoting and popularizing Opposer’s Trademark; the trade, industry, and public have throughout the years associated and attributed usage of Opposer’s Trademark to Opposer and Opposer alone, so that the trade in general and the purchasing public in

particular have come to know and recognize Opposer's Trademark and Opposer's Goods and to know that the same originate with and belong to Opposer.

8. Opposer has used Opposer's Trademark in interstate commerce openly, notoriously and continuously since the date of first use of Opposer's Trademark.
9. Opposer's Trademark is a strong trademark and has developed goodwill and a good reputation exclusive to Opposer.
10. Upon information and belief, Applicant is a corporation duly organized and existing under the laws of the State of Connecticut with offices at 63 Silvermine Road, Seymour, DE 06483.
11. The purported CottonEase mark applied for in Applicant's Application is confusingly and deceptively similar to Opposer's Trademark, which Opposer has been using long prior to the filing of Applicant's Application or any date Applicant may claim as priority; hence, Applicant is not entitled to adopt, use, or seek registration of the purported CottonEase mark in connection with the goods identified in Applicant's Application.
12. The goods identified in Applicant's Application are closely related to Opposer's Goods sold under Opposer's Trademark, and/or to goods likely to be distributed and sold by Opposer, allowing for Opposer's normal and foreseeable expansion of use of Opposer's Trademark.
13. The goods covered by Applicant's Application are of the type distributed and sold by Opposer, through the same channels of trade and to the same

class of customers as Opposer's Goods, and/or likely to be distributed and sold by Opposer, through the same channels of trade and to the same class of purchasers as Opposer's Goods, allowing for Opposer's normal and foreseeable expansion of use of Opposer's Trademarks. Such goods would reasonably be expected by the trade and purchasing public to emanate from or be sponsored by the same source.

14. Opposer's Trademark and Applicant's purported mark are confusingly similar in appearance, connotation and pronunciation, so that contemporaneous use of the respective marks will create a likelihood of confusion, mistake or deception among the trade and consumers.
15. Applicant's purported mark incorporates the whole of Opposer's Trademark COTTON-EASE.
16. Because of the strength and fame of Opposer's Trademark and because Applicant's purported mark is nearly identical thereto, any faults or imperfections in the goods of Applicant will reflect adversely on Opposer and its established goodwill and reputation, all to the detriment of Opposer unless this opposition is sustained.
17. The simultaneous use and/or registration by Applicant of the mark CottonEase will dilute and tarnish Opposer's rights and will eventually result in a lack of designation or indication of origin and a loss of distinctiveness and exclusivity in Opposer's Trademark if Applicant is allowed to register its purported mark.

18. Opposer clearly has superior and paramount rights as compared to Applicant and Opposer has used Opposer's Trademark in commerce continuously since 2002, a date prior to any date claimed by or available to Applicant. Consequently, Opposer avers that confusion, mistake, deception, dilution and tarnishment in the trade and in the minds of the purchasers as between Opposer's and Applicant's marks and as to the origin of their respective goods will be likely and bound to occur with resulting damage to Opposer.

WHEREFORE, Opposer respectfully requests that the Opposition be sustained and that registration of Application Serial No. 85525666 to Applicant for the mark CottonEase be refused.

Dated: Scarsdale, New York
July 18, 2012

Respectfully submitted,

LACKENBACH SIEGEL, LLP

By: 

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CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the enclosed **NOTICE OF OPPOSITION** was served on counsel for Applicant on July 18, 2012, via U.S. 1st Class Mail, addressed to counsel for Applicant as follows:

Richard D. Getz, Esq.
O'Shea Getz P.C.
1500 Main Street, Suite 912
Springfield, Massachusetts 01115

Dated: Scarsdale, New York
July 18, 2012



Nicole Saraco

EXHIBIT 1

Int. Cl.: 23

Prior U.S. Cl.: 43

United States Patent and Trademark Office

Reg. No. 3,187,172

Registered Dec. 19, 2006

TRADEMARK
PRINCIPAL REGISTER

COTTON-EASE

ORCHARD YARN AND THREAD COMPANY,
INC. (NEW YORK CORPORATION), DBA
LION BRAND YARN COMPANY
34 WEST 15TH STREET
NEW YORK, NY 10011

FOR: KNITTING AND CROCHET YARNS MADE
IN WHOLE OR SUBSTANTIAL PART OF COTTON,
IN CLASS 23 (U.S. CL. 43).

FIRST USE 5-20-2002; IN COMMERCE 5-20-2002.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 1,788,214.

SER. NO. 78-815,143, FILED 2-15-2006.

DANIEL CAPSHAW, EXAMINING ATTORNEY

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-18 13:49:32 ET

Serial Number: 78815143 Assignment Information

Trademark Document Retrieval

Registration Number: 3187172

Mark

COTTON-EASE

(words only): COTTON-EASE

Standard Character claim: Yes

Current Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: 2006-12-19

Filing Date: 2006-02-15

Transformed into a National Application: No

Registration Date: 2006-12-19

Register: Principal

Law Office Assigned: LAW OFFICE 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2006-12-19

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. ORCHARD YARN AND THREAD COMPANY, INC.

DBA/AKA/TA/Formerly: DBA LION BRAND YARN COMPANY

Address:

ORCHARD YARN AND THREAD COMPANY, INC.

International Class: 023
Class Status: Active
 KNITTING AND CROCHET YARNS MADE IN WHOLE OR SUBSTANTIAL PART OF COTTON
Basis: 1(a)
First Use Date: 2002-05-20
First Use in Commerce Date: 2002-05-20

International Class: 023

KNITTING AND CROCHET YARNS MADE IN WHOLE OR SUBSTANTIAL PART OF COTTON

First Use Date: 2002-05-20

First Use in Commerce Date: 2002-05-20

Prior Registration Number(s):

MADRID PROTOCOL INFORMATION

PROSECUTION HISTORY

2006-12-19 - Registered - Principal Register

2006-10-03 - Published for opposition

2006-09-13 - Notice of publication

2006-08-09 - Law Office Publication Review Completed

2006-08-04 - Assigned To LIE

2006-08-02 - Approved for Pub - Principal Register (Initial exam)

2006-08-02 - Examiner's Amendment Entered

2006-08-02 - Examiners amendment e-mailed

2006-08-02 - Examiners Amendment -Written

2006-08-01 - Assigned To Examiner

2006-02-22 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

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No assignment has been recorded at the USPTO

For Serial Number: 78815143

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v2.3.2
Web interface last modified: July 10, 2012 v2.3.2

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